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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,533	12/29/2000	Stephen M. Coutts	252312005704	1380
25226	7590	02/09/2004		
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			EXAMINER LUKTON, DAVID	
			ART UNIT 1653	PAPER NUMBER

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,533

Applicant(s)

COUTTS ET AL.

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22-98 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Pursuant to the directives of the amendment filed 1/5/04, claims 22, 32, 36, 38, 41, 42, 44, 45, 51-55, 57, 59, 61 have been amended, and claims 64-98 added. Claims 22-98 are pending.

Claims 44 and 45 remain withdrawn from consideration pursuant to the first restriction/election.

The previous specie election (compound 3-II, figure 6A.) remains in force.

*

Restriction to one of the following inventions is required under 35 U.S.C. §121 (the numbering begins with Group 7, to avoid conflict with previous assigned numbers):

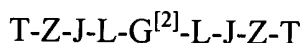
7. Claims 22-43, 46-63, 65, 81, 82, 98, drawn to compounds in which a single "line of symmetry" is required.

8. Claims 64, 66-80, 83-97, drawn to compounds in which a "line of symmetry" is not required.

The claimed inventions are distinct. Clearly, asymmetric molecules are different from symmetrical molecules, and one is not obvious over the other.

This restriction is imposed despite the fact that a "first action on the merits" (FAOM) has

issued. However, a genus that is defined in terms of a "line of symmetry" could not have been envisioned at the time of the first Office action. First, there was no mention of this in any of the claims. Second, there is no mention of the phrase "line of symmetry" anywhere in the specification. Third, claim 22 (and all claims dependent thereon) constitute new matter. A complete explanation as to why claim 22 represents new matter will not now be provided. But what is probably the single most important reason for this conclusion is the following. Applicants, in their response filed 1/5/04, have pointed to various formulas in the specification. For example, on page 13 of the response, it is argued that the following has a line of symmetry (formula simplified below):



However, a necessary (though not sufficient) condition for such a molecule to be symmetrical would be for the structure represented as variable $G^{[2]}$ to itself be symmetrical. The specification does not describe this. Similarly, the structures represented as variables $G^{[6]}$ and $G^{[7]}$ would have to be symmetrical; there is no description of $G^{[1]}$, $G^{[2]}$, $G^{[6]}$ or $G^{[7]}$ being symmetrical. Nor is there a statement that the remaining substituent variables should be selected so that the resulting molecule is symmetrical.

In addition, the term "single line of symmetry", without further qualification, has no particular meaning to organic or inorganic chemists. The subject of symmetry is discussed, e.g., in Cotton & Wilkinson (*Advanced Inorganic Chemistry*, pages 3-46, John

Wiley & Sons, 1972). Perhaps the terms “axis of symmetry” or “plane of symmetry” would have meaning. But in the absence of a description, the term “single line of symmetry” is not meaningful. Furthermore, the elected specie does not have just one line of symmetry; it has at least two. The first line of symmetry (or plane of symmetry) bisects the “PEG” portion of the molecule, leaving a phenyl group on each side. But a second line of symmetry (or plane of symmetry) would “bisect” the molecule such that on one side of the line, $\frac{1}{2}$ of a phenyl group would be present, and on the other side half a phenyl group would also be present, i.e., the second line of symmetry is perpendicular to the first. This lack of clarity as to what is intended only bolsters the argument for new matter.

The issue at this point is not new matter *per se*. The primary issue is that of the distinction between groups 7 and 8; a secondary issue is that of a restriction subsequent to the FAOM. But if a genus is presented subsequent to the FAOM, and that genus is not described in the specification as filed, it follows therefrom that (a) the genus thus presented is distinct from any that has been previously presented, and (b) an examiner could not have envisioned, at the time of the initial restriction, the new genus thus presented. Clearly, groups 7 and 8 are distinct from one another. Separate searches would be required.

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Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at 571-272-0951.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



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